

#19
2 of 3

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Robert T. Bell, et al.
Serial No.: 09/032,083
Filing Date: February 27, 1998
Group Art Unit: 2663
Examiner: Huy D. Vu
Title: SYSTEM AND METHOD FOR PERFORMING SIGNALING
ON BEHALF OF A STATELESS CLIENT

RECEIVED
APR 17 2002
Technology Center 2100

Honorable Assistant Commissioner
for Patents
BOARD OF APPEALS AND INTERFERENCES
Washington, D.C. 20231

Express Mail #EL 953699513 US I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date shown below. <i>Willie Jiles</i> _____ Willie Jiles <i>April 11, 2002</i> _____ Date
--

Dear Sir:

REPLY BRIEF

Appellants have appealed to this Board from the decision of the Examiner, contained in a final Office Action mailed May 23, 2001, finally rejecting Claims 1-12, 14-32, and 34-105. Appellants submit this Reply Brief in response to the Examiner's Answer mailed on February 13, 2002.

STEN
47

REPLY

Appellants' Appeal Brief sets out in detail why the claims under appeal are allowable and why the Examiner's final rejection of these claims should therefore be reversed. Appellants respectfully submit, however, that the Examiner's Answer fails to meaningfully respond to Appellants' showing. Instead, it appears that the Examiner has merely reiterated his arguments from the Final Office Action while adding conclusory language rejecting Appellants' arguments.

The Examiner's Conclusory Statements Fail To Rebut Appellants' Demonstration Of Support In The Specification As Originally Filed For Packet-Based Communications.

In his Answer, the Examiner states four times that the specification fails to provide support for claimed limitations yet provides no analysis. *Examiner's Answer*, at page 15. The Examiner simply dismisses Appellants' detailed discussion without guidance as to why packet-based communications are not disclosed by elements such as packet-based networks and media stream communications taking place over these packet-based networks. In the interest of brevity, Appellants submit that the Appeal Brief, on pages 3-5, provides a detailed analysis of the support for the claimed limitation that "the media stream communications session between the stateless client and the state-based client comprises packets."

Appellants' Declaration Under 37 CFR § 1.131 Is Sufficient And Effective To Overcome *Kikinis*.

With an appropriate showing of facts in a declaration submitted under 37 CFR § 1.131, an applicant may overcome a reference such that it may not be used for rejections under 35 U.S.C. § 102 (a) or (e) or 35 U.S.C. § 103 (a). For a declaration to be effective, 37 CFR § 1.131 (b) requires that:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

Thus, in the present case, the facts asserted in the declaration must show either (a) reduction to practice of the invention prior to the effective date of *Kikinis* (the “Effective Date”); (b) a conception of the invention prior to the Effective Date coupled with due diligence from prior to the Effective Date to a subsequent reduction to practice; or (c) conception of the invention prior to the Effective Date coupled with due diligence from prior to the Effective Date to the filing date of the Application. The Examiner improperly rejects Appellants’ Declaration as insufficient and ineffective, stating that “[t]he submitted **evidence** fails to show [(a), (b), or (c) above].” *Examiner’s Answer*, at page 16 (emphasis added). It is apparent that the Examiner has confused the requirement of facts with the requirement for accompanying exhibits.

First, let us address the facts from the Declaration of Appellants originally submitted on August 22, 2001. In the Declaration, Robert Bell (one of the inventors) states that:

Prior to the Effective Date, my co-inventors and I developed a complete understanding and appreciation of the subject matter of the above-referenced invention. With the help of a patent attorney, we generated a draft of the Application that, prior to the Effective Date, was substantially identical to and included all of the subject matter of the Application as filed.

This fact demonstrates, at the very least, a conception of the invention prior to the Effective Date. The facts of the Declaration further show that the efforts that began prior to the Effective Date continued up until the filing of the Application. These facts include Bell’s statement that: “Between the Effective Date and our filing date on February 27, 1998, a period of ten days, we finalized the paperwork in anticipation of filing.” Thus the facts show diligence for the brief period that began prior to the Effective Date and lasted through the filing of the Application (this period is less than two weeks, from February 17 to February 27 of 1998). The Declaration therefore satisfies at least element (c), which requires conception of the invention prior to the Effective Date coupled with due diligence from prior to the Effective Date to the filing date of the Application.

In addition to facts, 37 CFR § 1.131 also requires that “[o]riginal exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.” In his Declaration, Bell states that a

draft of the application substantially identical to the application as filed was created prior to the Effective Date. Since the application as filed was already a part of the record, resubmitting a copy with the Declaration would do little more than bloat the file. Mr. Bell's Declaration did include an attached Affidavit, which while already a part of the record, provides emphasis to the diligence during the extremely short time from the Effective Date to the filing of the Application. Therefore, the Declaration satisfies the requirements of 37 CFR § 1.131, and thus Kikinis may not, alone or in combination, be used to support rejections of any of the pending Claims in the Application.

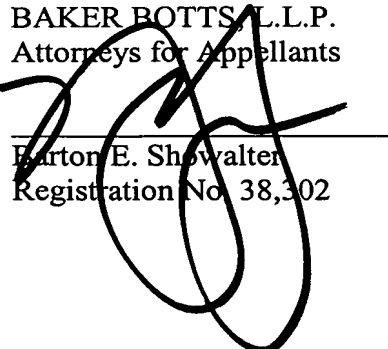
CONCLUSION

Appellants thoroughly demonstrated in the Appeal Brief the support for claimed limitations and why the cited art is either inappropriate or fails to disclose, teach, or suggest the limitations of the Claims. The Examiner's Answer does not in any way controvert Appellants' showing. Accordingly, Appellants respectfully request the Board to reverse the Examiner's final rejection of Claims 1-12, 14-32, and 34-105 and to instruct the Examiner to issue a Notice of Allowance of these Claims.

Although Appellants believe no fee is due in connection with this Reply Brief, the Commissioner is hereby authorized to charge any fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS, L.L.P.
Attorneys for Appellants



Barton E. Showalter
Registration No. 38,302

2001 Ross Avenue
Dallas, Texas 75201-2980
Phone: 214.953.6509
Fax: 214.953.6503

Date: April 9, 2002